



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,221	04/09/2004	Roberto A. Franco	MSFT122100	1314
26389 7590 05/13/2008 CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347				
EXAMINER				
LEE, JINHEE J				
ART UNIT		PAPER NUMBER		
2175				
MAIL DATE		DELIVERY MODE		
05/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/822,221

**Applicant(s)**

FRANCO ET AL.

**Examiner**

Jinhee J. Lee

**Art Unit**

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2007 and 11 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Individual Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 8-13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Shafron (7107548).

Re claim 1, Shafron discloses a method comprising:

(a) generating a user interface that identifies add-ons associated with an application program and responds to user input for managing the enable/disable state of said add-ons (controllable user interface with information or functionality using controlling software program, see abstract for example), the add-ons comprising small software programs pluggable into the application program for adding functionality to the application program (controllable user interface with information or functionality using controlling software program for example); and

(b) in response to user input, managing the enable/disable state of said add-ons (controlling using the controlling software program, see abstract for example) by:

(i) determining if the user has selected a list of add-ons (see column 2 lines 38-42 and abstract for example);

(ii) if the user has selected a list of add-ons, determining if the user has selected a particular add-on from the list (see column 3 lines 8-10 for example);

(iii) if the user has selected a particular add-on from the list, determining if the user has chosen to disable or enable the particular add-on (updates and recontacts the section of add-on unless disabled or closed, see abstract, column 2 lines 23-25 and column 16 lines 12-17 for example);

(iv) if the user has chosen to disable the particular add-on, disabling the add-on (see column 16 lines 12-17 for example); and

(v) if the user has chosen to enable the add-on, enabling the add-on (see column 3 lines 8-10 for example).

Re claim 2, Shafron discloses a method, wherein said add-ons are chosen from the group comprising ActiveX.RTM. controls, browser helper objects, and toolbar extensions (see column 3 line 14 for example).

Re claim 3, Shafron discloses a method, wherein said add-ons include ActiveX.RTM. controls, and wherein the method further comprises updating said ActiveX.RTM. controls, in response to user input (dynamically, see column 1 lines 14-15 and column 2 lines 23-25 for example).

Re claim 4, Shafron discloses a method, wherein at least some of said add-ons are included in an explicit list of administrator-denied add-ons, and wherein the method

further comprises prohibiting the enablement of said administrator-denied add-ons in response to user input (see column 15 lines 43-47 for example).

Re claim 5, Shafron discloses a method, wherein at least some of said add-ons are included in an explicit list of administrator-approved add-ons, and wherein the method further comprises allowing the disablement of said administrator-approved add-ons in response to user input (see column 16 lines 12-17 for example).

Re claim 8, Shafron discloses a method, wherein said user interface includes at least one list of add-ons chosen from the group of lists comprising add-ons that have been used by the application program, add-ons currently loaded for use with the application program, and add-ons currently blocked for use with the application program (see column 2 lines 38-42 and column 3 lines 30-37 for example).

Re claim 9, Shafron discloses a computer-readable storage medium comprising: generating a user interface that identifies add-ons associated with an application program and responds to user input for managing the enable/disable state of said add-ons (controllable user interface with information or functionality using controlling software program, see abstract for example); the computer-executable instructions including instructions that, when executed, cause said data processing device to :

(a) generate a user interface that identifies add-ons associated with the application program and responds to user input for managing the enable/disable state of said add-ons (controllable user interface with information or functionality using controlling software program, see abstract for example) and

(b) in response to user input, manages the enable/disable state of said add-ons (controllable user interface with information or functionality using controlling software program, see abstract for example) by:

(i) determining if the user has selected a list of add-ons (see column 2 lines 38-42 and abstract for example);

(ii) if the user has selected a list of add-ons, determining if the user has selected a particular add-on from the list (see column 3 lines 8-10 for example);

(iii) if the user has selected a particular add-on from the list, determining if the user has chosen to disable or enable the particular add-on (updates and recontacts the section of add-on unless disabled or closed, see abstract, column 2 lines 23-25 and column 16 lines 12-17 for example);

(iv) if the user has chosen to disable the particular add-on, disabling the add-on (see column 16 lines 12-17 for example); and

(v) if the user has chosen to enable the add-on, enabling the add-on (see column 3 lines 8-10 for example).

Re claim 10, Shafron discloses a computer-readable storage medium, wherein said add-ons are chosen from the group comprising ActiveX.RTM. controls, browser helper objects, and toolbar extensions (see column 3 line 14 for example).

Re claim 11, Shafron discloses a computer-readable storage medium, wherein said add-ons include ActiveX.RTM. controls, and wherein the method further comprises updating said ActiveX.RTM. controls, in response to user input (dynamically see column 1 lines 14-15 and column 2 lines 23-25 for example).

Re claim 12, Shafron discloses a computer-readable storage medium, wherein at least some of said add-ons are included in an explicit list of administrator-denied add-ons, and wherein the method further comprises prohibiting the enablement of said administrator-denied add-ons in response to user input (see column 15 lines 43-47 for example).

Re claim 13, Shafron discloses a computer-readable storage medium, wherein at least some of said add-ons are included in an explicit list of administrator-approved add-ons, and wherein the method further comprises allowing the disablement of said administrator-approved add-ons in response to user input (see column 16 lines 12-17 for example).

Re claim 16, Shafron discloses a computer-readable storage medium, wherein said user interface includes at least one list of add-ons chosen from the group of lists comprising add-ons that have been used by the application program, add-ons currently loaded for use with the application program, and add-ons currently blocked for use with the application program (see column 2 lines 38-42 and column 3 lines 30-37 for example).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 6, 7, 14,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shafron in view of Bloomberg et al. ( 20020196279 ).

Re claim 6, Shafron substantially discloses a method as set forth in claim 1 above. Shafron does not explicitly disclose, wherein an administrator of the application program has the capacity to disable a user's ability to manage the add-ons. However, Bloomberg et al. teaches of wherein an administrator of the application program has the capacity to disable a user's ability to manage the add-ons (need to authenticate, see paragraph 0038 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein an administrator of the application program has the capacity to disable a user's ability to manage the add-ons as taught by Bloomberg et al. on the method of Shafron in order to provide privacy in information provided in the add-on.

Re claim 7, Shafron substantially discloses a method as set forth in claim 1 above. Shafron does not explicitly disclose, wherein said user interface identifies add-



ons by displaying information selected from the group comprising the name of the add-on, the publisher of the add-on, the status of the add-on, the type of add-on, and the time when the add-on was lastly accessed. However, Bloomberg et al. teaches of wherein said user interface identifies add-ons by displaying information selected from the group comprising the name of the add-on, the publisher of the add-on, the status of the add-on, the type of add-on, and the time when the add-on was lastly accessed (see paragraph 0039 and 0044 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein said user interface identifies add-ons by displaying information selected from the group comprising the name of the add-on, the publisher of the add-on, the status of the add-on, the type of add-on, and the time when the add-on was lastly accessed as taught by Bloomberg et al. on the method of Shafron in order to provide privacy in information provided more information about the add-on.

Re claim 14, Shafron substantially discloses a computer-readable storage medium as set forth in claim 9 above. Shafron does not explicitly disclose, wherein an administrator of the application program has the capacity to disable a user's ability to manage the add-ons. However, Bloomberg et al. teaches of wherein an administrator of the application program has the capacity to disable a user's ability to manage the add-ons (need to authenticate, see paragraph 0038 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein an administrator of the application program has the capacity to disable a

user's ability to manage the add-ons as taught by Bloomberg et al. on the method of Shafron in order to provide privacy in information provided in the add-on.

Re claim 15, Shafron substantially discloses a computer-readable storage medium as set forth in claim 9 above. Shafron does not explicitly disclose, wherein said user interface identifies add-ons by displaying information selected from the group comprising the name of the add-on, the publisher of the add-on, the status of the add-on, the type of add-on, and the time when the add-on was lastly accessed. However, Bloomberg et al. teaches of wherein said user interface identifies add-ons by displaying information selected from the group comprising the name of the add-on, the publisher of the add-on, the status of the add-on, the type of add-on, and the time when the add-on was lastly accessed (see paragraph 0039 and 0044 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein said user interface identifies add-ons by displaying information selected from the group comprising the name of the add-on, the publisher of the add-on, the status of the add-on, the type of add-on, and the time when the add-on was lastly accessed as taught by Bloomberg et al. on the method of Shafron in order to provide privacy in information provided more information about the add-on.

### ***Response to Arguments***

6. Applicant's arguments filed 12/17/07 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation in the preamble has not been given patentable weight because the recitation occurs in the preamble. A preamble is

generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's arguments that Safron does not teach "generating a user interface that identifies add-ons associated with an application program and responds to user input for managing the enable/disable state of said add-ons", examiner disagrees. The abstract of Safron teaches of "generating a user interface" by disclosing the displaying an internet browser interface; teaches "that identifies add-ons associated with an application program" by disclosing that the controlling software program is used to enable the user, the content provider, or the ISP to customize and control the information and or functionality of the user's browser, therefore the controlling software program is used to identify the add-ons associated with an application program which is provided by the ISP for example. Further, Safron teaches of "responds to user input for managing the enable/disable state of said add-ons" as claimed since Safron teaches that the controlling software program responds to the user input since the user can be allowed to customize the displayed output on the interface.

In response to applicant's arguments that Safron does not teach "in response to user input, managing the enable/disable state of said add-ons by determining if the user has selected a list of add-ons", examiner disagrees. The abstract of Safron teaches of that the controlling software program enables the user to customer and

control the information displayed on the browser interface. Controlling and allowing for customization i.e. determining what is displayed or not displayed is managing the enable/disable state of add-ons.

Furthermore, the applicant's claim describes add-ons as "comprising small software programs pluggable into the application program for adding functionality to the application program". The "advertisements, coupons, news, HTML links, etc ...toolbars, pull-down menus, plug-ins, applications, etc" meets the description of add-ons in the claimed limitation.

In response to applicant's arguments that Safron does not teach "determining if the user has selected a particular add-on from the list", examiner disagrees. For example, column 3 lines 8-10 of Safron teaches displaying with the browser interface the information or functionality chosen when the user has done the customizing. This teaches that the invention of Safron has determined if the user has selected a particular add-on from a list.

In response to applicant's arguments regarding "if the user has chosen to enable the add-on, enabling the add-on", examiner points out that the by customizing what is displayed, the user has chosen to enable the add-on.

In response to applicant's arguments regarding "disabling the add-on", examiner points out that ability to customize allows for disabling of the add-ons.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M-F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on 571-272-2100 ext. 75. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jinhee J Lee/  
Primary Examiner, Art Unit 2174

jji